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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JONAS LOWELL STEINMAN, FRANK WILLIAM
DAUGHERTY, DARREL E. HERBST, and LUKAS C. OBERHUBER

Appeal 2008-6374
Application 09/412,013
Technology Center 3600

Decided:¹ March 24, 2009

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Jonas L. Steinman, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 2-16, 19-34, 36-51, 71-79, and 81-85. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

The invention is a system and method for rewarding a user of a website for accessing a website. (Specification 1:36-29.) The system awards the user points for clicking on hyperlinks within the website. (Specification 1:32-34.) The points are tallied and used to enter the user in a sweepstakes. (Specification 2:2-3.)

Claim 71, reproduced below, is illustrative of the subject matter on appeal.

71. A method of entering a user in a sweepstakes comprising:
providing a website for access by a user, the website including a plurality of hyperlinks to services and webpages in the website, and each of the plurality of hyperlinks having an associated point value indicative of any number of points the user can get for clicking on the hyperlink, wherein

² Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed May 10, 2007) and the Examiner's Answer ("Answer," mailed July 19, 2007).

at least two hyperlinks of the plurality of hyperlinks have different associated point values, the associated point values for the plurality of hyperlinks being stored in look-up table stored in a web server associated with the website;

receiving a request that indicates that the user has clicked on one of the plurality of hyperlinks;

determining a point value associated with the one of the plurality of hyperlinks by looking up the associated point value in the look-up table;

awarding, based on the point value associated with the one of the plurality of hyperlinks, at least one point to the user as a result of the user clicking on the one of the plurality of hyperlinks; and

awarding, based on a predetermined number of at least one point awarded to the user for clicking on the one of the plurality of hyperlinks, at least one entry in a sweepstakes.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Eggleston

US 6,061,660

May 9, 2000

Gunther, Marc, *The Trouble With Web Advertising*, Fortune, Apr. 1999, at 147. (Herein after Gunther.)

The Examiner took Official Notice that it is old and well known to use look up tables for looking up and matching information. (Answer 4.)

The following rejection is before us for review:

1. Claims 2-16, 19-34, 36-51, 71-79, and 81-85 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gunther in view of Eggleston and Official Notice.

ISSUES

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 19-33, 72-75, 83 and 85 under 35 U.S.C. § 103(a) as unpatentable over Gunther in view of Eggleston and Official Notice. The issue turns on whether the combination of Gunther, Eggleston and Official Notice would have led one of ordinary skill in the art to a method including the step of providing a website having hyperlinks to services and webpages in the website.

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 2-16, 34, 76-79, and 82 under 35 U.S.C. § 103(a) as unpatentable over Gunther in view of Eggleston and Official Notice. The issue turns on whether the combination of Gunther, Eggleston and Official Notice would have led one of ordinary skill in the art to a system having a website including hyperlinks to services and webpages in the website.

The third issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 36-51, 81, and 84 under 35 U.S.C. § 103(a) as unpatentable over Gunther in view of Eggleston and Official Notice. The issue turns on whether the combination of Gunther, Eggleston and Official Notice would have led one of ordinary skill in the art computer code performing the step of providing a website including hyperlinks to services and webpages in the website.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 71 recites a method including a website, “the website including a plurality of hyperlinks to services and webpages in the website.”
2. Claim 76 recites a system including a website, “wherein the website includes a plurality of hyperlinks to services and webpages in the website.”
3. Claim 81 recites a computer code embedded in a storage medium performing the step of providing a website, “the website including a plurality of hyperlinks to services and webpages in the website.”
4. Claim 85 recites a method including providing a website, “the website including a plurality of hyperlinks to services and webpages in the website.”

The scope and content of the prior art

Gunther

5. Gunther relates to a rewards program that gives users of a website points for viewing pages and buying things in order to attract viewers and advertisers. (Pg. 1, Abstract.)
6. The abstract on page one of Gunther states:

With a glut of space to sell, media outfits on the Internet are fighting for viewers and advertisers, and only the most ingenious sites will survive. SportsLine USA has created a “rewards” program that gives users points, similar to airline frequent-flier miles, for viewing pages and buying things.

7. The further the fourth paragraph on page one of Gunther states:

So why is SportsLine paying people to visit its site? It doesn't call it that, exactly, but SportsLine has crated a “rewards” program that gives users points, similar to airline frequent-flier miles, for viewing pages and buying things. An avid sports fan (or anyone with nothing better to do) who visits frequently and clicks on enough pages can exchange points for T-shirts, movie passes, \$5 and \$10 restaurant certificates, hockey pucks, and baseballs, along with automatic entries in a \$1 million sweepstakes. As you surf through all the freebies, it's easy to forget why you came in the first place-to check the scores.

8. Gunther, in the fifth paragraph on page one, states that media companies on the internet are competing for advertisers and viewers.
9. Gunther does not describe the “pages” as being for different advertisers and is silent as to content of the “pages.”

Eggleston

10. Eggleston relates to a system and method for incentive programs.
11. Eggleston states, “Combinations of different types of incentive programs may be selected; for example, an incentive program may be built in which the consumer plays a pinball game in which the consumer is eligible to win customer loyalty points, and upon

winning enough points, the consumer is eligible for a sweepstakes prize.” (Col. 30, l. 63 – Col. 31, l. 1.)

Official Notice

12. The Examiner took Official Notice that it is old and well known to use look up tables for looking up and matching information.

(Answer 4.)

Any differences between the claimed subject matter and the prior art

13. Gunther does not describe a plurality of hyperlinks to services and webpages in the website.

The level of skill in the art

14. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of generating traffic at internet websites. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”)

(Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

15. The Examiner asserts that it would have been obvious to a person of ordinary skill in the art at the time of Appellants’ invention to have included associating different point values to the different

advertisers links because such a modification allows different advertisers to offer a higher point value to users who click on the links to their websites and therefore increase their traffic flow.

(Answer 3-4.)

Secondary considerations

16. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). “[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The Method Claims 19-33, 71-75, 83 and 85

The Examiner rejected independent claims 75 and 85 under 35 U.S.C. § 103(a) as being unpatentable over Gunther in view of Eggleston and Official Notice. The rejection is based on the Examiner’s finding of fact that Gunther taught hyperlinks that link to different advertisers on a website. (Answer 3.) The Examiner used this fact to conclude the claimed invention was obvious. (Answer 3.) The Examiner states:

...since Gunther also teaches the links are from different advertisers that gives incentives and

compete for viewers (page 1, paragraph IV, V and page 3) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included associating different point values to the different advertisers links because such a modification allow *[sic]* different advertisers to offer a higher point value to users who click on the links to their websites and therefore increase their traffic flow.

(Answer 3-4.) The Examiner also states, "Gunther teaches granting points as a result of clicking on hyperlinks. The hyperlinks being for different advertisers (page 1)." (Answer 4.)

The Appellants argue that independent claims 71 and 85 require hyperlinks to services and webpages in the website and that links to advertisers are links to services and webpages that are external to the website. (App. Br. 11 and 20.)

Claim 71 states, "the website including a plurality of hyperlinks to services and webpages in the website." (FF 1.) Claim 85 includes the same limitation. (FF 4.)

We have determined that the Examiner erred in rejecting claims 71 and 85 for the following reasons. We find that Gunther does not teach the pages (i.e. hyperlink) being from different advertisers (FF 9) as asserted by the Examiner (Answer 4). While Gunther does describe a user clicking on "pages" (FF 7) and that the purpose of the reward system is to attract advertisers to view the website (FF 6 and 8), Gunther does not associate the "pages" with the advertisers. Gunther is silent as to the pages' content and location. We note that even if Gunther did teach the "pages" as being for different advertisers, then the limitation in claims 71 and 85 requiring the

hyperlinks to be to services and webpages *in the website* would not be met. As the Appellants argue, advertisers' links to services and webpages would be *external* to the website.

Further, the Examiner did not make any other finding as to whether one of ordinary skill in the art would be led by the "pages" in Gunther to the claimed website including a plurality of hyperlinks to services and webpages *in the website*. The Examiner also did not make any findings as to whether Eggleston or the ordinary skill in the art would teach including hyperlinks to services and webpages *in the website*.

Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claims 71 and 85 by failing to make a prima facie case of obviousness. Accordingly, we reverse the rejection of claims 71 and 85. Claims 19-33, 72-75 and 83 depend from claims 71, and their rejection is likewise reversed.

The Apparatus Claims 2-16, 34, 76-79, and 82

Independent claim 76 recites a system having a website including a plurality of hyperlinks to services and webpages in the website. (FF 2.) For the reasons discussed above with respect to claims 71 and 85, we find that one of ordinary skill in the art would not have been led by Gunther and Eggleston to a system having the claimed hyperlinks to services and webpage in the website. Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claim 76. Accordingly, we reverse the rejection of claim 76. Claims 2-16, 34, 74-79, and 82 depend from claim 76, and their rejection is likewise reversed.

The Article Claims 36-51, 81, and 84

Independent claim 81 recites a computer code embedded in a storage medium performing the step of providing a website including a plurality of hyperlinks to services and webpages in the website (FF 3). For the reasons discussed above with respect to claims 71 and 85, we find that one of ordinary skill in the art would not have been led by Gunther to a computer code performing the step of providing a website including a plurality of hyperlinks to services and webpages in the website as required by claim 81. Therefore, we find that the Appellants have shown that the Examiner erred in rejecting claim 81. Accordingly, we reverse the rejection of claim 81. Claims 36-51 and 84 depend from claim 81, and their rejection is likewise reversed.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 2-16, 19-34, 36-51, 71-79, and 81-85 under 35 U.S.C. § 103(a) as unpatentable over Gunther in view of Eggleston and Official Notice.

DECISION

The decision of the Examiner to reject claims 2-16, 19-34, 36-51, 71-79, and 81-85 is reversed.

Appeal 2008-6374
Application 09/412,013

REVERSED

JRG

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